

Application No. 09/480,724
Amendment dated April 11, 2005
In response to Office Action dated January 11, 2005

Remarks

Applicants acknowledge that claims 20-39 and 42 are pending in the present application.

Claims 20, 22, 24, 25, and 42 have been amended to clarify the scope of the claims, and Applicants respectfully submit that the amendments should be admitted under 37 C.F.R. § 1.116.

35 U.S.C. § 103 (Non-obviousness)

Claims 20-39 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Shaughnessy (U.S. Patent No. 6,317,726) in view of "India: Financial ratios... 1999" (Businessline). Applicants respectfully traverse the rejection and submit that claims 20-39 and 42 are patentable for the reasons provided below.

In order for a 35 U.S.C. §103 rejection to be proper, a *prima facie* case of obviousness must be established. *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995). The *Manual of Patent Examining Procedure (MPEP)* states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

MPEP, § 2142, at 2100-128 (8th ed., Rev. 2, 2004) (emphases added). The prior art of record, even when combined together, does not teach or suggest all the claim limitations of the present application. With regard to the first criterion above, the prior art of record clearly does not teach, suggest, or motivate one of ordinary skill in the art to combine and modify the teachings of the two references in the manner suggested by the Examiner to produce the claimed limitation.

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Compared to the methods and strategies disclosed and claimed in O'Shaughnessy, the method of the present application enjoys a distinctive beauty of simplicity.¹ Both independent claims 20 and 42 of the present application require (1) "ranking according to price appreciation to assign each of said available securities one or more separate price appreciation ranks," (2) "ranking according to said return on assets ratio to assign each of said available securities a separate return on assets ratio rank," and (3) "ranking according to said price to cashflow ratio to assign each of said available securities a separate price to cashflow rank." Although O'Shaughnessy teaches the concept of "price to cashflow" ratio and Businessline teaches the concept of "return on assets," the prior art of record does not teach or suggest to rank a group of securities according to their price to cashflow ratios or their return on assets ratios and then select securities based on a combination of these rankings.

O'Shaughnessy teaches, among a number of value factors, that price to cashflow ratio is a measure of whether a stock is cheap or not, and that stocks with low price to book, price to cashflow, and price-to-sales ratios outperform other stocks. However, O'Shaughnessy does not teach to use price to cashflow ratio to rank a group of stocks and assign each stock a separate rank. Neither does O'Shaughnessy teach or suggest that the actual ranks assigned to the stocks according to their price to cashflow ratios will be useful in selecting securities to form an investment portfolio. In all the methods, models, or strategies taught and/or claimed in O'Shaughnessy, cashflow (or any value related to it) is merely used to identify stocks having cashflow (or cashflows per share) greater than a database mean. See O'Shaughnessy,

¹ Under U.S. law, simplicity is not a proper factor for obviousness analysis, see *In re Chu*, 66 F.3d 292, 298, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984), but a hallmark of invention. See *Diamond Rubber v. Consolidated Rubber Tire*, 220 U.S. 428, 434-35, 31 S.Ct. 444, 447 (1911); *Demaco v. Langosdroff Licensing*, 851 F.2d 1387, 1391, 7 USPQ2d 1222, 1225 (Fed. Cir. 1988).

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col. 11, line 31; col. 13, line 46; col. 14, line 9; col. 15, line 27; col. 18, lines 38-39 and 56-57; col. 19, lines 11-12; col. 20, lines 42 and 59-60; col. 22, lines 41-42; col. 23, lines 33-34; col. 31, lines 5-6; col. 33, lines 5-6, 24-25, and 50-51; col. 34, lines 3-4, 23-24, and 39-40; col. 35, lines 66-67; col. 36, lines 17-18, 38-39, and 56-57; col. 37, lines 5-6. By identifying stocks having cashflow (or cashflows per share) greater than a database mean, O'Shaughnessy teaches to identify stocks having the lowest price to cashflow ratios. However, O'Shaughnessy does not teach or suggest to rank a group of available stocks according to their price to cashflow ratios, and then use the ranking, either alone or in combination with other separate rankings, to select stocks.

O'Shaughnessy actually teaches to sort (i.e., rank) stocks according to price appreciation, dividend yield, or price-to-sales ratio into a sorted list, but it does not teach or suggest to sort stocks according to price to cashflow ratio even though O'Shaughnessy discloses the concept of "price to cashflow" ratio. Applicants respectfully submit that this fact reflects that the inventor of O'Shaughnessy did not contemplate that the ranking of stocks according to price to cashflow ratio would be useful and should be included in his invention.

The Office Action admits that O'Shaughnessy does not teach a return on assets ratio, and refers to Businessline for the needed teaching. However, although Businessline teaches the concept of "return on assets" and teaches that return on assets is a good measure of how profitably a company is using the funds it has raised, it does not teach or suggest to rank securities according to their return on assets ratios and to use this ranking, either alone or in combination with other separated rankings, to select securities. Businessline does not teach or suggest to rank securities according to price to cashflow ratio as well.

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Moreover, although O'Shaughnessy teaches to sort a first set, a second set, and a third set of securities according to price appreciation, dividend yield, and price-to-sales ratio in a seriatim manner, it does not teach to sort the same set of securities using any three (or even two) value factors to assign each security in the set of securities three (or even two) separate ranks and then combine the three (or even two) separate ranks to form a group of ranked securities.

Therefore, O'Shaughnessy and Businessline, even when combined together, do not teach or suggest all the claim limitations of claims 20 and 42. For this reason alone, the Office Action has failed to establish a *prima facie* case of obviousness.

Another fatal defect in the Office Action is that it fails to identify any teaching or suggestion to modify the prior art of record in the manner suggested by the Examiner to arrive at the claimed subject matter. As stated above, O'Shaughnessy does not teach or suggest to sort stocks according to price to cashflow ratio, and does not teach to combine price to cashflow ratio with price appreciation in selecting securities, much less to combine sorting according to price to cashflow ratio and sorting according to price to cashflow ratio to form a group of sorted securities. O'Shaughnessy even does not teach to sort the same group of securities using two or more value factors. Neither O'Shaughnessy nor Businessline teaches to sort securities according to return on assets ratio. Therefore, in order to get the invention claimed in claim 20 or 42, one would need to (1) modify O'Shaughnessy to sort stocks according to price to cashflow ratio; (2) modify Businessline to sort stocks according to return on assets ratio; (3) combine the teaching of Businessline with the teaching of O'Shaughnessy; and (4) combine sorting according to price to cashflow ratio, sorting according to price appreciation, and sorting according to return on assets ratio together to form a group of

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sorted stocks. Applicants respectfully assert that the Office Action has not shown sufficient motivation or suggestion in the prior art for one of ordinary skill in the art to make any of these modifications, let alone the entire complex combination. See, e.g., *Yamouchi Pharm. Co. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000).

Although O'Shaughnessy teaches that "using several factors allows one to enhance performance or reduce risk," it continues to warn,

However, just cumulating additional factors does not increase the performance: if to one took Large Stocks with PE ratios below 20 and positive earnings gains for the year and bought the 50 with the best 1-year price performance, one would actually earn less than if one bought the low PE, high relative strength stocks alone. The addition of positive earnings gains hurt performance in this instance. More factors do not necessarily mean better performance.

Col. 9, line 66 to col. 10, line 6. Based on O'Shaughnessy's teaching, one of ordinary skill in the art would be deterred to modify the methods taught in O'Shaughnessy, and would be motivated not to combine price appreciation, price to cashflow ratio, and/or return on assets ratio in the manner suggested by the examiner against the teaching of O'Shaughnessy, because one would be motivated to closely follow the combinations of value factors and methods taught by O'Shaughnessy to avoid hurting performance.

Businessline teaches the concept of "return on assets," but does not teach or suggest to sort securities according to return on assets ratio and assign each stock a separate return on assets ratio rank. Neither does it teach or suggest to combine a stock's return on assets ratio rank with one or more other separate ranks assigned to the stock by sorting stocks according to one or more other factor to form a group of ranked stocks. Aside from hindsight use of Applicants' specification, there is no suggestion in either O'Shaughnessy or Businessline to a person of ordinary skill that the specific claimed factors should be combined in the manner

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claimed. Out of the hundreds of factors that conceivably could be used to select securities, the applicants have found that the combination of price appreciation, return on assets ratio and price to cashflow ratio in the manner as claimed by the present application achieve useful results. Nothing in the references of record teaches or suggests this novel combination.

Therefore, independent claims 20 and 42 are not obvious over the prior art of record and are allowable.

Claims 21-39 are dependent on claim 20 and are allowable for the same reasons as claim 20. In addition, these claims are limited to additional features not taught or suggested by the references of record.

For example, claim 22 requires that the ranking of claim 20 further comprises "determining for each of said available securities an average rank comprising the average of the one or more separate price appreciation ranks, separate return on assets ratio rank and separate price to cashflow ratio rank for said security." Nothing in O'Shaughnessy or Businessline teaches or suggests such a limitation, which is totally novel and nonobvious. The prior art of record in fact does not teach or suggest to get an average rank of a security by averaging any two or more separate ranks of the same security according to two or more different value factors. The Examiner cites four sections of O'Shaughnessy to support its rejection, but none of them (or any other place in O'Shaughnessy or Businessline) teaches or suggests averaging together any two or more separate ranks assigned to a stock according to different selection factors in the manner claimed by the present invention, much less an average of the separate ranks assigned to the stock according to the three specific factors described in the claim. Therefore, claim 22 is allowable at least for this extra reason. So is claim 23 that depends from claim 22 and further defines the determining step: "wherein said

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determining comprises determining for each of said available securities an average rank comprising the average of the separate first rate rank, the separate second rate rank, the separate return on assets ratio rank and the separate price to cashflow ratio rank."

For another example, claim 24 is limited to a method of selecting stocks wherein the available securities are only ranked according to the three factors—price appreciation, return on assets ratio and price to cashflow ratio. Neither O'Shaughnessy nor Businessline teaches or suggests predetermined factors consisting only of these three factors, so claim 24 is allowable at least for this extra reason.

In conclusion, the prior art of record does not make out a *prima facie* case of obviousness, and claims 20-39 and 42 are in condition for allowance.

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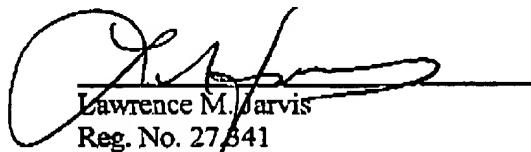
Conclusion

In view of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of 20-39 and 42, and all claims declared patentable. A Notice of Allowance is therefore respectfully solicited.

There is no fee believed to be due, but the Commissioner is authorized to charge any additional fees or credit overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

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Respectfully submitted,



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